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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,411	08/13/2007	Kenji Sakamoto	SAKA0101PUSA	4009
22045 7590 09/11/2009 BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075				
EXAMINER				
MELLER, MICHAEL V				
ART UNIT		PAPER NUMBER		
1655				
MAIL DATE		DELIVERY MODE		
09/11/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/598,411

Applicant(s)

SAKAMOTO ET AL.

Examiner

Michael V. Meller

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3, 4, 7, 11, 13, 15, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. These claims are rejected since the structures that appear in claim 3 are compounds not formulas. Further, the appearance of the compounds before the mentioning that the antibacterial agent comprises one or more compounds selected from isoflavan compounds shown in formulae (1), (2), (3), and (4) is confusing. It would be clearer if the claim recited the compounds at the end of the claim. Thus, the claim can read, "An antibacterial agent comprising one or more compounds selected from the group consisting of compounds (1), (2), (3) and (4) wherein the compounds are : " and then list the structures. Further, each of claims 4, 7, 11, 13, 15, 17 will have to be amended to reflect this change, since they suffer from the same problem.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ma et al., Pharmazie, 57, 2002, pages 75-76.

Ma teaches that Formula 2 is known, see page 75, first structure. The compounds are identified as having anti-hypertensive activity, thus constituting in the very least, a pharmaceutical composition. Since the same compound as claimed is taught by Ma then the compound inherently has antibacterial activity. Since an extract from *Eysenhardtia adenostylis* reads on the claimed compound of formula 2, then the extract is taught. Since there is nothing in the specification

to define what applicants consider to be an "effective amount", any amount will meet this claim limitation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ma et al., Pharmazie, 57, 2002, pages 75-76.

Ma teaches that Formula 2 is known, see page 75, first structure. The compounds are identified as having anti-hypertensive activity, thus constituting in the very least, a pharmaceutical composition. Since the same compound as claimed is taught by Ma then the compound inherently has antibacterial activity. Since an extract from *Eysenhardtia adenostylis* reads on the claimed compound of formula 2, then the extract is taught. Since there is nothing in the specification to define what applicants consider to be an "effective amount", any amount will meet this claim limitation.

In the event that it is seen that there is not an effective amount of the antibacterial or that the compound is not a pharmaceutical (which this examiner does not agree with) it would have been obvious for one having ordinary skill in the art at the time the invention was made to use an effective amount of the compound for antibacterial effects since Ma makes it clear that the compounds are known to be used for anti-hypertensive activity and one would want to use effective amounts to achieve that desired effect. Further, it is obvious to use the compound as a pharmaceutical since it is known to have anti-hypertensive effects which would clearly be a pharmaceutical purpose. Further to use effective amounts of an antibacterial would also be obvious in an effort to prevent any bacterial infections in the patient that is being treated with the compound.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael V. Meller
Primary Examiner
Art Unit 1655

/Michael V. Meller/
Primary Examiner, Art Unit 1655